

**REMARKS**

Claims 21-38 are pending.

**A. Claims 21-37 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Pond et al. (US 5,886,690) in view of Bergstedt (US 6,750,886) and Schilit et al. (US 5,627,980). The Applicant respectfully traverses this rejection for the following reason(s).**

**Claim 21**

Claim 21 calls for, in part, *an input unit for inputting a display command for displaying a sub-list having a predetermined number of files selected in an entire list of the files recorded in a recording medium.*

In the art of television, a channel is a communication path defined by a predetermined frequency, terms, such as "Species" and "Financial News" identify a program on a channel, and terms such as CNN and TBS are names representing a broadcast company. None of the foregoing are "files".

The Examiner states "Pond, however, doesn't explicitly state that the channels are files," and refers us to Bergstedt, column 1, lines 18-49, and in particular, the Examiner suggests that "paged content is a list of files" and refers to Bergstedt's col. 1, lines 18-36.

Bergstedt discloses in col. 1, lines 18-36 "Computer monitors are used for the display of information or "content" in a window-type graphical user interface (GUI). The content can take the form of text, graphics, images, etc., examples of which are document files, file folder/directory lists,

internet web pages (including those displayed within frames), spreadsheets, databases, digital photographs, drawings, pull-down menu lists, etc. Frequently the window is not large enough to display the entire contents of the file, folder, etc. In such cases, the user can view the additional "off-screen" information by using a mouse-controlled cursor to select and move (by dragging) a slider bar, clicking on up or down arrows to scroll one "line" (the amount of the "line" movement varies in different products and instances, but is always an amount less than one "page") at a time, or by clicking the mouse with the cursor positioned in the scroll bar but not on the slider bar (which moves the file or folder content up or down one "page" or window at a time).

The page up or page down operations (referred to herein as paging operations) can also be implemented by pressing the page up or page down keys on the keyboard. Paging and scrolling operations can be implemented horizontally as well as vertically. **Paging and scrolling operations are also used to display information other than in a window-type GUI."**

Accordingly, in col. 1, lines 37-49, however, Bergstedt clearly refers to the paging function being utilized "**to display information other than in a window-type GUI,**" and then identifies this display of other information on, for example, "a handheld computer such as a personal digital assistant (PDA), in television display of information **such as an electronic program guide** or internet web pages, on internet appliances, and on a mobile telephone" (emphasis added).

**At no point does Bergstedt equate channels to files. Bergstedt merely cites examples of paging operations.**

Nor does Schilit equate channels with files.

Note that a television show can be displayed on a computer monitor, with proper encoding.

And files can be displayed on a computer monitor. That does not mean a television show is equivalent to a file. However, the Examiner would have us believe that a television show is equivalent to a file.

Pond's invention utilizes a digital satellite system for receiving programs broadcast by a satellite network. The satellite receiving system comprises an antenna 12 in the form of a parabolic reflector dish, a feedhorn and low noise block down converter/amplifier assembly (LNB) 14. The satellite receiving system further comprises an integrated television receiver/descrambler (IRD) 16 with an accompanying remote control unit 18 and a conventional television receiver/monitor 22.

Pond is silent with regard to where the electronic program guide originates and how it is delivered.

An electronic program guide is usually information imbedded in a vertical blanking interval of a television signal. This signal is not a file.

Additionally, there has been no showing that a list of channels in a displayed electronic program guide is a set of files. Although an electronic program guide lists channels, the electronic program guide is not a file when received at the television system nor when it is displayed on a television screen.

There has been no showing that a list of channels in a displayed electronic program guide is a set of files. Accordingly, the rejection of claim 21 is deemed to be in error and should be withdrawn.

Also, the Examiner's motivation for combining Pond and Bergstedt is untenable.

The Examiner states it would have been obvious to one of ordinary skill in the art, having the teachings of Pond and Bergstedt to include files in a paging display. One would have been motivated to make such a combination because a means to substitute a sub-list of items with a subsequent sub-list of items, instead of replacing one item at a time, would be desirable in any list of items (programs, files, images, etc.) that can't be simultaneously displayed.

However, Pond already discloses having a Page Mode. Pond discloses that remote control unit 18 includes PAGE key 40 which can be used to display a screen that allows the user to "page" forward, backward, up and down through various screens in a "page" mode. According to one aspect of the "page" mode, the up and down arrow keys will display only a selected subset of the available channels (i.e., ten (10) channels at a time) and the program screen guide includes a page bar for identifying the presence of any selectable program channels that are not present on the currently displayed channel bar. See Pond, col. 5, lines 22+.

Accordingly, the Examiner's basis of motivation to combine Pond and Bergstedt is without merit.

Additionally, on page 12 of Paper No. 20060823, paragraph 32, the Examiner acknowledges that Pond teaches paging of items in an electronic program guide. The question is one of whether or not one would have been motivated by Bergstedt to modify Ponds paging of items in an electronic program guide. Bergstedt clearly discusses two separate concepts, one of displaying files in a **in a window-type graphical user interface (GUI)** and one of displaying an electronic program guide **other than in a window-type GUI**. Bergstedt discussion of files in separate context than the

discussion of an electronic program guide is clear evidence that one of ordinary skill in the art would not have looked to Bergstedt's discussion of "files" to modify Pond's discussion of an electronic program guide.

There has been no showing that Pond's method of paging is deficient in any manner. Accordingly, there is no motivation for one of ordinary skill in the art to look to Bergstedt to try and improve Pond's paging ability.

Therefore, the Examiner's basis of motivation to combine Pond and Bergstedt is without merit. Schilit does not provide motivation for combining Pond and Bergstedt.

Accordingly, the rejection of claim 21 is deemed to be in error and should be withdrawn.

Claim 21 has been amended to reflect the Applicant's description found in paragraphs [0040] and [0041] with respect to Figs. 6-8. None of the applied references teach this feature.

#### **Claims 29 and 30**

Again, the Examiner relies on Pond's discussion with respect to "channels" and erroneously equates channels with files, then based on this erroneous interpretation of "files" looks to Bergstedt and Schilit for motivation to combine the references.

As has been demonstrated with respect to claim 21, channels are not the same as files. Accordingly, the basis for combining the references is untenable, and appears to be based on hindsight.

***In re Fine***, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)

One cannot use hindsight reconstruction to pick and choose among

isolated disclosures in the prior art to deprecate the claimed invention.

Even though some hindsight may be necessary in making a §103 rejection, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), *McLaughlin* qualifies the statement that some hindsight may be necessary by inclusion of "... and does not include knowledge gleaned only from applicant's disclosure."

Accordingly, the rejection of claims 29 and 32 is deemed to be in error and should be withdrawn.

Claim 29 has been amended to reflect the Applicant's description found in paragraphs [0040] and [0041] with respect to Figs. 6-8. None of the applied references teach this feature.

Therefore, the rejection of claims 21-37 under §103 should be withdrawn.

**B. Claim 38 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Pond et al. (US 5,886,690) in view of Bergstedt (US 6,750,886) and Schilit et al. (US 5,627,980), and in further view of van Zoest et al. (US 6,496,802). The Applicant respectfully traverses this rejection for the following reason(s).**

Zoest fails to provide the teachings noted as lacking in the combination of Pond, Bergstedt and Schilit. Claim 38 depends from claim 36/32, and is therefore deemed patentable for the same reasons as argued with respect to claim 32.

Accordingly, the rejection is deemed to be in error and should be withdrawn.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendent, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



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